

Docket No. 7234-111N1/10401339

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: KRAIG A. KIRSCHNER

Serial No.: 10/759,873
Filed: January 16, 2004
For: SEISMIC ADAPTER
Group Art Unit: 1713

APPEAL NO. _____

TRANSMITTAL OF APPEAL BRIEF

Mail Stop: Appeal Brief – Patents
Hon. Commissioner of Patents
P. O. Box 1450
Alexandria, Va 22313-1450

Sir:

Enclosed herewith is an Appeal Brief (in triplicate) and fee of \$250.00 for the above-identified application at the small entity rate.

 X Applicant hereby requests a one-month extension of time to submit this Appeal Brief.

 An Oral Hearing is requested (two additional copies of the Brief are enclosed). The fee of \$260 is enclosed herewith.

 X The Commissioner is hereby authorized to charge payment of the Appeal Brief fee of \$250 and the Extension Fee of 460 at the Small Entity Rate or any required additional fees associated with this communication, or credit any overpayment, to Deposit Account 50-0337.

 X I hereby certify that this paper and an Appellant's Brief in triplicate (along with the Appendix-Claims, fee and anything else referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date of signature hereof with sufficient postage as first class mail in an envelope addressed to: Mail Stop: Appeal Brief – Patents; Commissioner of Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

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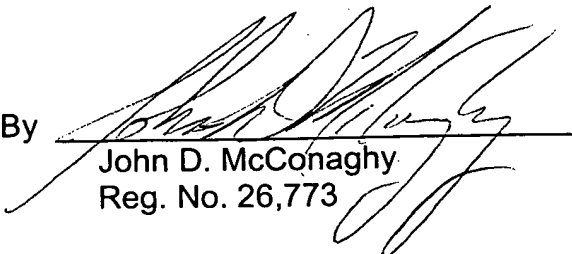
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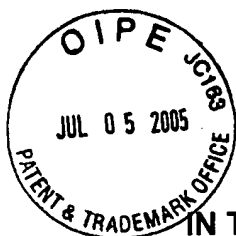
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: KRAIG A. KIRSCHNER)	Group Art Unit: 1713
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Serial No. 10/759,873)	Examiner: James R. Brittain
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APPEAL BRIEF UNDER 37 C.F.R 41.37

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Honorable Commissioner:

Real Party In Interest

Automated Fire Control, Incorporated

Related Appeals And Interferences

None.

Status Of Claims

The application was filed with three claims. These three claims remain as originally filed and stand rejected.

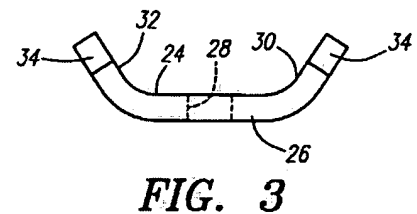
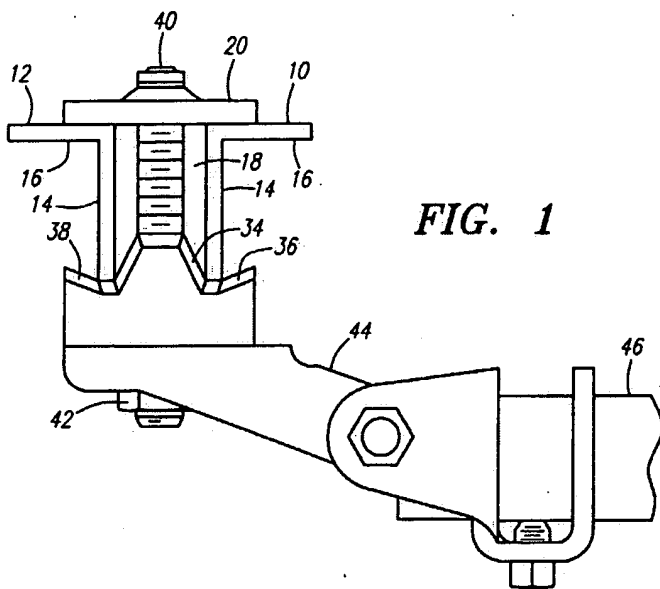
Status Of Amendments

None filed.

Summary Of Claimed Subject Matter

The claims are directed to a seismic suspension system. The system comprises a steel web joist, an anchor plate, an engagement plate and a stud.

The steel web joist includes a beam with two angle elements 10, 12 (page 3, lines 17-18). Each of the two angle elements 10, 12 has a first leg 14 and a second leg 16 (page 3, lines 18-19). The first legs 14 are parallel with a cord space 18 therebetween (page 3, lines 19-20). The second legs 16 extend in opposite directions (page 3, lines 20-21).



The anchor plate 20 extends across the cord space 18 and extends in juxtaposition with each second leg 16 (page 4, lines 1-3). The anchor plate 20 includes a first hole 22 therethrough (page 4, lines 3-4).

The engagement plate 24 includes a flat anchor portion 26 having a second hole 28 therethrough (page 4, lines 6-7) and upstanding engagement portions 30, 32 to

either side of the flat anchor portion 26 (page 4, lines 7-8). The engagement plate 24 extends across the cord space 18 opposite the anchor plate 20 (page 5, lines 3-7). Each upstanding engagement portion 30, 32 is at an obtuse angle substantially greater than 90° to the flat anchor portion 26 (page 4, lines 9-11) and has a distal edge with an engagement profile 34, 36, 38 abutting and being in interlocking engagement with the first legs 14 (page 4, lines 13-19).

The stud 40 extends from the first hole 22 to and beyond the second hole 28 (page 4, line 20 – page 5, line 1). The stud 40 is adapted to secure the anchor plate 20 and the engagement plate 24 to the beam 10, 12 of the steel web joist (page 5, lines 3-7).

The stud 40 is threaded (page 4, lines 22-23) and the anchor plate 20 is a square flat plate with the first hole 22 therethrough being centrally positioned and threaded (page 4, lines 3-4) to engage the threaded stud 40 (page 4, lines 20-22).

Each engagement profile including a tongue 34 extending between the first legs 14 of the steel web joist in the cord space 18 and shoulders 36, 38 to either side of the tongue 34 (page 4, lines 13-16).

Grounds Of Rejection To Be Reviewed On Appeal

Claims 1-2 – Obvious over Applicant's described prior art, Specification page 2, lines 1-11 and AFCON Flier 962 (Evidence Appendix), in view of Koyama, US Patent No. 5,259,165 and Rebentisch, US Patent No. 4,784,552.

Claim 3 – Obvious over Applicant's described prior art, Specification page 2, lines 1- 11 and AFCON Flier 962, in view of Koyama, US Patent No. 5,259,165, and Rebentisch and further in view of Steinke, US Patent No. 4,408,928.

Claims 1-3 – Obvious-type double patenting over claims 1-3 of parent patent, US Patent No. 6,749,359, in view of Rebentisch.

Argument

Before turning in detailed to the specific rejections, it is believed that a short discussion of the nature and advantages of the present invention is in order. The present invention is directed to a seismic suspension system. The combination is distinguished over Applicant's prior device (applied "described prior art" - Evidence Appendix) and over the additional applied references by the engagement plate which has upstanding engagement portions to either side of a flat anchor portion. Each upstanding engagement portion is at an obtuse angle substantially greater than 90° to the flat anchor portion and has a distal edge with an engagement profile abutting and being in interlocking engagement with the beam. These features are reflected in the claim recitations.

The advantages of this device, realized by these distinguishing features, include a mechanism allowing greater lateral location and stability, greater flexibility and the imposition of anchoring forces which achieve a higher contact pressure and an advantageous angle of approach to the anchoring contact.

Rejection under 35 USC 103 – claims 1-2

MPEP Section 2142 states the basis for a *prima facie* case of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitation.

Claims 1 and 2 were rejected as obvious over the description of Applicant's prior seismic adaptor in view of Koyama, U.S. Patent No. 5,259,165, and Rebentisch. All three criteria required for a *prima facie* case of obviousness are not supported by the references.

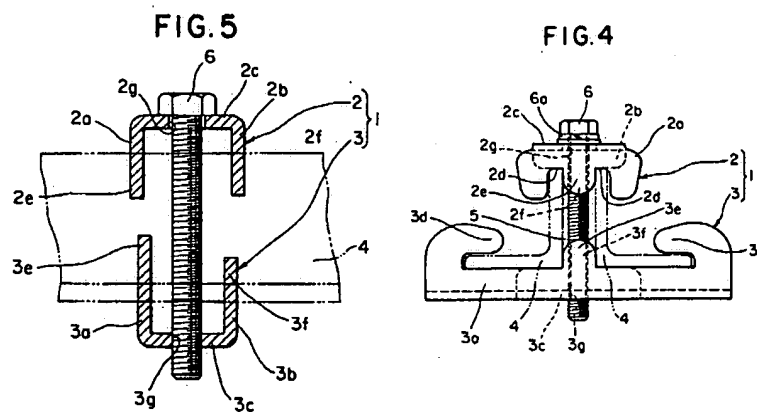
Applicant's prior seismic adapter is described in the Evidence Appendix. Effectively and in summary, this prior seismic adapter includes a flat, square upper plate, a flat, square lower plate, both with holes therethrough and a stud extending therebetween. The difference between the prior adapter and that which is claimed in the appealed claims is that the flat lower plate of the prior device is replaced by the engagement plate as recited in claim 1 presently at issue. The engagement plate is novel beyond the "flat anchor portion having a second hole therethrough": Claim 1 recites:

...an engagement plate including a flat anchor portion having a second hole therethrough and upstanding engagement portions to either side of the flat anchor portion, the engagement plate extending across the cord space opposite the anchor plate, each upstanding engagement portion being at an obtuse angle substantially greater than 90° to the flat anchor portion and having a distal edge with an engagement profile abutting and being in interlocking engagement with the first legs....

Thus, it is the recitations of the "engagement portions" in claim 1 that provide novelty to the combination over the Applicant's prior design. This is recognized in the Final Official Action, page 4, lines 8-12.

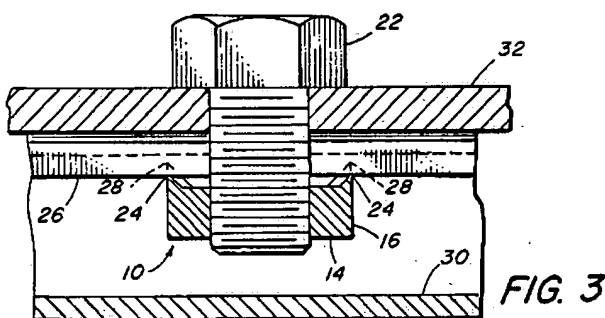
To supplement the admission of prior art, the Final Official Action combines the teachings of Koyama with Applicant's admission. Koyama employs two formed structures held on a beam by a common stud. These two structures provide engagement interaction with the beam. However, relevant to the third criteria required

for a *prima facie* case of obviousness, Koyama fails to provide “upstanding engagement portions” with each portion being “at an obtuse angle substantially greater than 90° to the flat anchor portion”. In Figures 4 and 5 (illustrated) it is evident that the portions 2a, 2b engaging the beam 4 are at right angles to the flat central portion 2c. The recitations of appealed claims 1 and 2 are not satisfied by Koyama. The third criteria that the references must teach or suggest all the claim limitations is not supported by Koyama.



Relevant to the first criteria required for a *prima facie* case of obviousness, the elements 2 and 3 are formed to retain the two angle elements of the beam 4 in place rather than to create a suspension device and, therefore, are part of the beam structure. Indeed, element 3 can only be assembled over the end of the beam and not with the beam already in place in a structure such as would be required for a hanger. Further, the device is inverted in that there is no stud extending beyond the second hole in element 2. If used with the beam 4 oriented the same as the present case The first criteria that there be some suggestion or motivation is not taught in either the admission or in Koyama. The devices have different purposes and applications and Koyama cannot be used as a hanger.

Rebentisch is applied in the Official Action with the assertion:



7.

anchor portion either. Therefore, the third criteria of a *prima facie* case of obviousness is not supported through the addition of Rebentisch. The references must teach or suggest all the claim limitations. Rebentisch doesn't add what is missing to the admitted prior seismic adapter and to Koyama.

Looking to the first and second criteria for a *prima facie* case, Rebentisch discloses a bolt 22 and a nut 10. This combination does not provide an attachment on a beam and then additionally operate as a hanger. It simply clamps two elements together. The combination does not provide secure anchor on a steel web joist as described. It also does not define a structural part to hold a beam of two angles together as in Koyama. There is no provision for its application. There is no suggestion or motivation for any combination with either the prior art hanger or the Koyama beam structure. There is also no particular understanding of what the nut 10 would do to create a working structure satisfying the utility of a device of either of claims 1 and 2.

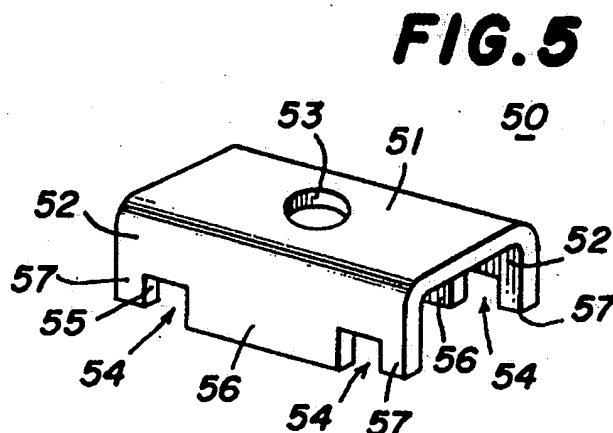
In the foregoing analysis, it is observed that the prior seismic adapter has no upstanding engagement portions, Koyama has no angled engagement portions and Rebentisch has no engagement plate, no flat anchor portion and no upstanding engagement portions of a plate at any angle. As such, the combination of references fails to teach or suggest all of the claim limitations. The third criteria for a *prima facie* case of obviousness cannot be met by these references. The references are also observed to have divergent uses, no common purpose and no expectation of cooperation among the components picked and chosen from each by the Official Action. The first and second criteria also are unsupported by these references as well and no *prima facie* case is made out.

The elements of appealed claims 1 and 2 are also significant to the utility of the invention of the present application and not mere design choices. The obtuse angle provides a structure which can be designed to provide a degree of flexibility which could not be realized in the Koyama or Rebentisch devices. The thickness of the engagement plate is design choice. However, the mechanism of the obtuse angle creates relatively more flexibility in terms of the response to a tightening of the studs than were the engagement portions perpendicular to the legs of the web joist. The obtuse angle also creates a wider base and greater lateral rigidity than that which is disclosed in Koyama. Again, it is a matter of design choice how rigid and how wide, once employing, the novel mechanism is of the obtuse orientations of the upstanding engagement portions. The distinguishing features of claims 1 and 2 are significant.

Rejection under 35 USC 103 – claim 3

Claim 3

Claim 3 was rejected over the references previously discussed with the addition of Steinke, U.S. Patent No. 4,408,928. Steinke discloses an element 50 with upstanding sidewalls 52 (illustrated) in a generally U-shaped structure as characterized in the Specification and shown in the drawings. As Claim 3 depends from Claim 1, the



foregoing arguments are equally applicable to this rejection. Steinke fails to provide any angled upstanding engagement element as set forth in the appealed claims. Further, Steinke discloses this bracket for holding channels together. As with Koyama and Rebentisch, the device is designed to hold two elements together structurally without any suggestion for additionally hanging another element. The specific claimed structure is missing, the suggestion or motivation for combining with other references is not present and differences in utility and application of the bracket from that of Koyama and Rebentisch exist in the teachings. Again, a *prima facie* case of obviousness cannot be sustained over Claim 3 in view of the applied references.

Rejection under obvious-type double patenting – claims 1-3

Looking to the non-statutory rejection based upon the claims of U.S. Patent No. 6,749,359 in view of Rebentisch, the Official Action applies Rebentisch in the same way as in the statutory rejection, the application of the nut 10 as an engagement portion of a plate. The same observations apply as above. The seismic suspension system of the present application is also designed to anchor onto a beam. The same features are missing from Rebentisch and the same dichotomy of purpose exists between the device of the parent patent and that of Rebentisch. The first and second criteria for a *prima facie* case of obviousness cannot be met by the claims of U.S. Patent No. 6,749,359 in view of Rebentisch.

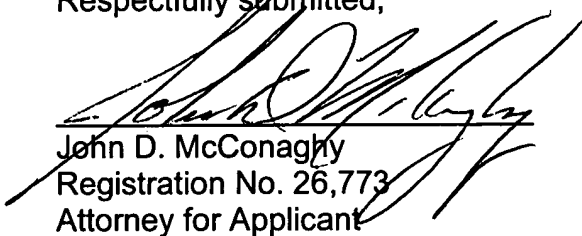
Conclusion

Thus, all of the prior seismic adapter, Koyama, Rebentisch and Steinke, taken independently or in combination, fail to provide support for a *prima facie* case of obviousness. The references fail to provide all of the limitations of the claims and fail to

even suggest or motivate a combination there among. The differences are substantial as presented in the asserted advantages of the present invention. The claims in U.S. Patent No. 6,749,359 are incompatible with Rebentisch, and there is no suggestion or motivation of any such combination. According to the criteria defined in MPEP § 2142, a *prima facie* case of obviousness cannot be established. Consequently, reversal of the final rejection is earnestly solicited.

June 28, 2005

Respectfully submitted,



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Claims Appendix

What is claimed is:

1. A seismic suspension system comprising
a steel web joist including a beam with two angle elements, each having a first leg and a second leg, the first legs being parallel with a cord space therebetween and the second legs extending in opposite directions;
5 an anchor plate extending across the cord space and in juxtaposition with each second leg and including a first hole therethrough;
an engagement plate including a flat anchor portion having a second hole therethrough and upstanding engagement portions to either side of the flat anchor portion, the engagement plate extending across the cord space opposite the anchor
10 plate, each upstanding engagement portion being at an obtuse angle substantially greater than 90° to the flat anchor portion and having a distal edge with an engagement profile abutting and being in interlocking engagement with the first legs;
a stud extending from the first hole to and beyond the second hole, the stud being adapted to secure the anchor plate and the engagement plate to the beam of the
15 steel web joist.
2. The system of claim 1, the stud being threaded and the anchor plate being a square flat plate with the first hole therethrough being centrally positioned and threaded to engage the threaded stud.
3. The system of claim 1, each engagement profile including a tongue extending between the first legs of the steel web joist in the cord space and shoulders to either side of the tongue.

Evidence Appendix – Relied upon by Examiner

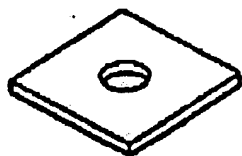
Specification page 2, lines 1-11:

[0004] Seismic adapters have been associated with such steel web joists by positioning two flat washers about one of the sets of angle elements. One washer lies in the plane of the second legs such that it extends across the cord space in juxtaposition with the second legs. A second washer is arranged to abut against the parallel edges of the first legs, also extending across the cord space. A threaded stud extends between the washers with a nut or bolt head retaining the first washer in juxtaposition with the second legs. The threaded stud extends beyond the second washer to accommodate attachment hardware. The entire assembly is then clamped to the joist by threading a nut up snug against the attachment hardware and, in turn, the second washer. Although this system is structurally sound, there is some prospect of limited lateral movement of the attachment.

Relevant portion of AFCON Flier 962:

962

SQUARE WASHER



ROD SIZE	HOLE SIZE	STOCK SIZE
3/8	7/16	1/4x2x2
1/2	9/16	1/4x2x2
5/8	11/16	1/4x2 1/2x2 1/2
3/4	13/16	1/4x2 1/2x2 1/2
7/8	15/16	3/8x3x3
1	1 1/8	3/8x4x4